



PATENT CASE: AL01381K

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

-----X
In re Application of:
Joseph A. Kozlowski et al.

For Patent For:
CANNABINOID RECEPTOR LIGANDS

Serial No.: **10/072,354**

Filed: **02/06/2002**
-----X

Examiner: **Janet Coppins**

Group Art Unit: **1625**

Date: **June 3, 2005**

Schering-Plough Corporation
Kenilworth, New Jersey 07033-0530

Mail Stop 313 (c)
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Petition for Withdrawal from Issue

Under 37 C.F.R. § 1.313(c)(2)

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Applicants respectfully request that the above-identified application be withdrawn from issue in view of the Request for Continued Examination under 37 C.F.R. § 1.114 and Information Disclosure Statement under 37 C.F.R. § 1.97(b)(4) filed herewith. The required fee under 37 C.F.R. § 1.17(h) is also enclosed herewith.

Withdrawal from issue is necessary to allow the Examiner to consider references cited in the International Search Report of the corresponding PCT application (PCT/US02/03672). Applicants inadvertently and without deceptive intent failed to submit these references.

With this Petition, Applicants have also filed amendments to the specification and claims to correct inadvertent errors. These amendments were previously submitted under 37 C.F.R. § 1.312 on January 6, 2004, but have apparently not yet been considered.

Respectfully submitted,

Serial No. 10/072,354

PATENT CASE: AL01381K

SCHERING-PLOUGH CORPORATION

TL A. BLC

Thomas A. Blinka
Attorney for Applicants
Reg. No. **44,541**
(908) 298-6791

Schering-Plough Corporation
Patent Department
Mail Stop K-6-1, 1990
2000 Galloping Hill Road
Kenilworth, NJ 07033-0530

DUPLICATE

PTO/SB/1 7p (11-04)

Approved for use through 07/31/2007. OMB 0651-0031

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PETITION FEE
Under 37 CFR 1.17(~, (g) & (h))
TRANSMITTAL

(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

| | |
|------------------------|----------------------------|
| Application Number | 10/072,354 |
| Filing Date | 02/06/2002 |
| First Named Inventor | Joseph A. Kozlowski et al. |
| Art Unit | 1625 |
| Examiner Name | Janet Coppins |
| Attorney Docket Number | AL01381K |

Enclosed is a petition filed under 37 CFR 1.313 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$130.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.

Payment of Fees (small entity amounts are NOT available for the petition fees)

☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 19-0365
☒ petition fee under 37 CFR 1.17(f), (g) or (h) ☒ any deficiency of fees and credit of any overpayments
Enclose a duplicative copy of this form for fee processing.

☐ Check in the amount of \$ is enclosed.

☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

For petitions filed under:

- § 1.53(e) - to accord a filing date.
- § 1.57(a) - to accord a filing date.
- § 1.182 - for decision on a question not specifically provided for.
- § 1.183 - to suspend the rules.
- § 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

For petitions filed under:

- § 1.12 - for access to an assignment record.
- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) - for patent owner requests for extension of time in ex parte reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in inter parte reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

- § 1.19(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.

Thomas A. Blinka

Signature

Thomas A. Blinka

Typed or printed name

June 3, 2005

Date

44,541

Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



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PETITION FEE
Under 37 CFR 1.17(~), (g) & (h)
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(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents
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| Application Number | 10/072,354 |
| Filing Date | 02/06/2002 |
| First Named Inventor | Joseph A. Kozlowski et al. |
| Art Unit | 1625 |
| Examiner Name | Janet Coppins |
| Attorney Docket Number | AL01381K |

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- ☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 19-0365
- ☒ petition fee under 37 CFR 1.17(f), (g) or (h) ☒ any deficiency of fees and credit of any overpayments
- Enclose a duplicative copy of this form for fee processing.
- ☐ Check in the amount of \$ _____ is enclosed.
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Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

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- § 1.57(a) - to accord a filing date.
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- § 1.183 - to suspend the rules.
- § 1.378(a) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

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JUN 08 2005

OFFICE OF PETITIONS**Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463**

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- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) - for patent owner requests for extension of time in *ex parte* reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in *inter parte* reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

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- § 1.19(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.

Signature

Thomas A. Blinka

Typed or printed name

June 3, 2005

Date

44,541

Registration No., if applicable

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PTO/SB/17 (12-04v2)

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Effective on 1210812004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 450.00)

Complete if Known

| | |
|----------------------|---------------------|
| Application Number | 10/072,354 |
| Filing Date | 02/06/2002 |
| First Named Inventor | Joseph A. Kozlowski |
| Examiner Name | Janet Coppins |
| Art Unit | 1625 |
| Attorney Docket No. | AL01381K |

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify):

☒ Deposit Account Deposit Account Number: 19-0365 Deposit Account Name: SCHERING-PLOUGH CORPORATION

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below

☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17

☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

| | FILING FEES | SEARCH FEES | EXAMINATION FEES | |
|------------------|-------------|-------------|------------------|----------------|
| Application Type | Fee (\$) | Fee (\$) | Fee (\$) | Fees Paid (\$) |
| utility | 300 | 500 | 200 | |
| Design | 200 | 100 | 130 | |
| Plant | 200 | 300 | 160 | |
| Reissue | 300 | 500 | 600 | |
| Provisional | 200 | 0 | 0 | |

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent 50

Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent 200

Multiple dependent claims 360

Total Claims - 20 or HP = Extra Claims Fee (\$) Fee Paid (\$)

HP = highest number of total claims paid for, if greater than 20

Indep. Claims - 3 or HP = Extra Claims Fee (\$) Fee Paid (\$)

HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41 (a)(1)(G) and 37 CFR 1.16(s).

Total Sheets - 100 = Extra Sheets Number of each additional 50 or fraction thereof Fee (\$) Fee Paid (\$)

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Additional Claim Fee

\$450.00

SUBMITTED BY

| | | | | | |
|-------------------|------------------|-----------------------------------|------------|-----------|--------------|
| Signature | Thomas A. Blinks | Registration No. (Attorney/Agent) | 44,541 | Telephone | 908-298-6791 |
| Name (Print/Type) | Thomas A. Blinks | Date | 06/03/2005 | | |

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/06 (12-04)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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| PATENT APPLICATION FEE DETERMINATION RECORD | | | | | | Application or Docket Number AL01381K | | | |
|---|---|--------------|------------------------------------|---------------|-----------------|---|-------------------------|-----------------|---------------------|
| Substitute for Form PTO-875 | | | | | | | | | |
| APPLICATION AS FILED – PART I | | | | | | | | | |
| (Column 1) | | (Column 2) | | SMALL ENTITY | | OR | OTHER THAN SMALL ENTITY | | |
| FOR | NUMBER FILED | NUMBER EXTRA | | RATE (\$) | FEE (\$) | | RATE (\$) | FEE (\$) | |
| BASIC FEE (37 CFR 1.18(a), (b), or (c)) | N/A | N/A | | N/A | | | N/A | | |
| SEARCH FEE (37 CFR 1.18(k), (l), or (m)) | N/A | N/A | | N/A | | | N/A | | |
| EXAMINATION FEE (37 CFR 1.18(o), (p), or (q)) | N/A | N/A | | N/A | | | N/A | | |
| TOTAL CLAIMS (37 CFR 1.16(l)) | 57 | minus 20 = | 37 | x | = | OR | x 18 = | 666 | |
| INDEPENDENT CLAIMS (37 CFR 1.16(h)) | 1 | minus 3 = | 00 | x | = | | x 84 = | 00.00 | |
| APPLICATION SIZE FEE (37 CFR 1.16(s)) | If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s). | | | | | | | | |
| MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j)) | | | | N/A | | | N/A | | |
| * If the difference in column 1 is less than zero, enter "0" in column 2. | | | | TOTAL | | | TOTAL | 666.00 | |
| APPLICATION AS AMENDED – PART II | | | | | | | | | |
| (Column 1) | | (Column 2) | (Column 3) | SMALL ENTITY | | OR | OTHER THAN SMALL ENTITY | | |
| AMENDMENT A | CLAIMS REMAINING AFTER AMENDMENT | | HIGHEST NUMBER PREVIOUSLY PAID FOR | PRESENT EXTRA | RATE (\$) | ADDITIONAL FEE (\$) | | RATE (\$) | ADDITIONAL FEE (\$) |
| | Total (37 CFR 1.16(l)) | 66 | Minus | 57 | = | 9 | OR | x 50 = | 450.00 |
| | Independent (37 CFR 1.16(h)) | 1 | Minus | 0 | = | 0 | OR | x 00 = | 00.00 |
| | Application Size Fee (37 CFR 1.16(s)) | | | | | | OR | | |
| | FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j)) | | | | | | OR | | |
| | | | | | N/A | | OR | N/A | |
| | | | | | TOTAL ADD'L FEE | | OR | TOTAL ADD'L FEE | 450.00 |
| AMENDMENT B | CLAIMS REMAINING AFTER AMENDMENT | | HIGHEST NUMBER PREVIOUSLY PAID FOR | PRESENT EXTRA | RATE (\$) | ADDITIONAL FEE (\$) | | RATE (\$) | ADDITIONAL FEE (\$) |
| | Total (37 CFR 1.16(l)) | | Minus | | = | | OR | x | = |
| | Independent (37 CFR 1.16(h)) | | Minus | | = | | OR | x | = |
| | Application Size Fee (37 CFR 1.16(s)) | | | | | | OR | | |
| | FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j)) | | | | | | OR | | |
| | | | | | N/A | | OR | N/A | |
| | | | | | TOTAL ADD'L FEE | | OR | TOTAL ADD'L FEE | |

* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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